

Applicants respectfully traverse the Restriction Requirement on at least two grounds. First, the Restriction Requirement does not follow the procedure set forth in 37 CFR §§

1.141-1.146 and the corresponding sections of the MPEP for handling generic claims.

According to 37 CFR § 1.141, an applicant may not claim two or more independent and distinct inventions in a single application “except that more than one species of an invention . . . may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim” (emphasis added). Thus, “[w]here an application contains a generic claim for all of the disclosed species, a restriction usually is not proper.” *R2 Medical Systems, Inc. v. Katecho, Inc.*, 931 F. Supp. 1397, 1436, n. 16, n. 17 (N.D. Ill. 1996).

The procedure for handling applications that include generic claims is set forth in 37 CFR § 1.146. This rule provides that “[i]n the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable.” As stated in MPEP § 809.02(a), “[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR § 1.141.” Thus, where generic claims are present, an applicant can be required to elect a species for initial examination, but the generic claims are still subject to examination to determine whether such generic claims are allowable.

In the instant case, the required procedure is not being followed. Claim 16 is a **proper** generic claim within the requirements set forth in 37 CFR § 1.141. In the Restriction Requirement, the Examiner alleges that the “generic linking claim 16 is improper, because different members of the claims are patentably distinct and thus not linked to each other” (see, page 2 of the Restriction Requirement). However, claim 16 satisfies the definition of a generic claim as set forth in MPEP § 806.04(d), in that this generic claim does not include limitations that are not present in all claims that depend from it. Therefore, claim 16 is, in fact, a proper generic claim. As such, in the present case, an election of species requirement is permissible, but a restriction requirement is not.

Moreover, because the restriction requirement splits a single claim, *i.e.*, claim 16, into multiple groups, *i.e.*, **four** groups, the restriction requirement is improper as a matter of law. The courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. See, *In re Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and *In re Haas* 198 USPQ 334-337 (*In re Haas II*) (CCPA 1978). As stated in *In re Weber*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim—no matter how broad, which means no matter how many independently patentable inventions may fall within it. 198 USPQ 328 at 334.

As such, the Examiner's statement that "the generic linking claim 16 is improper, because different members of the claims are patentably distinct and thus not linked to each other" is not proper grounds for issuing a restriction requirement (*see*, page 2 of the Restriction Requirement). Again, as mentioned above, the courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. § 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions.

Moreover, in a case such as the instant case, where a claim is generic, a Restriction Requirement is tantamount to a rejection of the claim. The CCPA made this point very clear in *In re Haas I*:

We find that the action taken by the examiner did in fact amount to a rejection. . . . Those claims were withdrawn from consideration not only in this application but prospectively in any subsequent application because of their content. In effect there had been a denial of patentability of the claims. Presumably only by dividing the subject matter into separate, and thus different, claims in plural applications could an examination of the patentability of their subject matter be obtained. 179 USPQ at 625.

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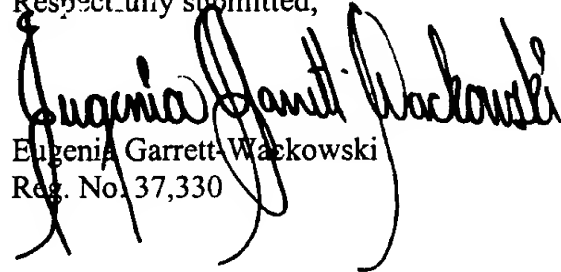
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If the Examiner has any questions regarding Applicants' election, or if the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (925) 572-5000.

Respectfully submitted,



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